

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM PHILIP SHAOUY and
MATTHEW BUNKLEY TREVATHAN

Appeal 2007-0987
Application 09/810,992
Technology Center 2100

Decided: May 24, 2007

Before LEE E. BARRETT, JOSEPH F. RUGGIERO, and
JEAN R. HOMERE, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants' disclosed invention relates to a method and apparatus for tailoring information to the characteristics of a user of an application

program such as a web browser. A request object, which contains profile elements that convey characteristics of the user, is transmitted from the application program to an arbiter. The arbiter performs an analysis of the request object and selects a personalization engine based on the outcome of the analysis. The request object is presented to the selected personalization engine which accesses a content database to retrieve a personalized content object which includes tailored information for the user. (Specification 2-3.)

We affirm.

Claim 1 is illustrative of the invention and it reads as follows:

1. A method for tailoring information to characteristics of an information user, comprising:
 - a) passing a request object containing at least one profile element to an arbiter;
 - b) actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines by the arbiter, the arbiter refining and altering a selection based on a number and type of the profile element;
 - c) accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter.

The Examiner relies on the following prior art references to show unpatentability:

Kurtzman, II	US 6,044,376	Mar. 28, 2000
Jacobi	US 6,064,980	May 16, 2000
Kadowaki	US 6,313,921 B1	Nov. 6, 2001 (filed Sep. 18, 1998)
Tetzlaff	US 6,556,963 B1	Apr. 29, 2003 (filed Sep. 24, 1997)

Forecast Pro Product Description Brochure (Forecast Pro), December 2000, web pages (unnumbered) available at http://web.archive.org/web/*/www.forecastpro.com (last visited Oct. 13, 2005).

Claims 18-20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Forecast Pro. Claims 1-17 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Kadowaki in view of Forecast Pro with respect to claims 1, 2, 4, 6, 8, 9, and 12-17, adds Kurtzman, II to the basic combination respect to claims 3, 5, 10, and 11, and adds Jacobi and Tetzlaff to the basic combination with respect to claim 7.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details.

ISSUES

(i) Under 35 U.S.C § 102(a), does Forecast Pro have a disclosure which anticipates the invention set forth in claims 18-20?

(ii) Under 35 U.S.C § 103(a), with respect to appealed claims 1-17, has the Examiner established a prima facie case of obviousness based on Kadowaki taken in separate combinations with the secondary references to Forecast Pro, Kurtzman, II, Jacobi, and Tetzlaff?

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann*

Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed. Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

35 U.S.C. § 102(a) REJECTION

With respect to claims 18-20, Appellants’ arguments in response to the Examiner’s 35 U.S.C. § 102(a) rejection initially assert (Br. 6) that the Forecast Pro reference is not a valid reference since the Examiner has not established that such reference has a publication date prior to the March 16, 2001 filing date of Appellants’ application. After reviewing the arguments presented by the Examiner (Answer 13), however, we find ourselves in agreement with the Examiner’s position as stated in the Answer. In our view, the skilled artisan would have recognized and appreciated that the numbers “20001209085500” appearing at the bottom of the Forecast Pro web pages correspond to the date, i.e., December 9, 2000, that the web pages were publicly available. It is our opinion that, absent any evidence forthcoming from Appellants that proves otherwise, the printed dates on the Forecast Pro web pages retrieved from the “archive.org” web site, as well as the copyright date of 2000 on the last of the retrieved web pages, establish that the cited Forecast Pro reference is a an applicable prior art reference. *In re Epstein*, 32 F.3d 1559, 1567, 31 USPQ2d 1817, 1822 (Fed. Cir. 1994)

(“in the absence of evidence to support this speculation, we do not find appellant’s argument persuasive”).

Turning to the merits of the 35 U.S.C. § 102(a) rejection of claims 18-20 based on the disclosure of Forecast Pro, the Examiner indicates (Answer 3) how the various limitations are read on the disclosure of Forecast Pro. In particular, the Examiner directs attention to the second full paragraph (designated by the Examiner as “item 1”) on page 1 of Forecast Pro.¹ According to the Examiner (*id.*), the described “historic data,” “expert system,” and “forecasting technique” selection corresponds to the claimed “profile element,” “arbiter,” and “personalization engine” selection.

In our view, the Examiner’s analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a *prima facie* case of anticipation. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner’s *prima facie* case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived; *see* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants’ response asserts that the Examiner has not shown how each of the claimed features is present in the disclosure of Forecast Pro so as to establish a *prima facie* case of anticipation. Our review of Appellants’ arguments (Br. 7-8; Reply Br. 2-3), however, reveals that Appellants have

¹ The Examiner’s statement of the grounds of rejection cites various passages from Forecast Page and designates them as “item” numbers, i.e., “item 1,” “item 2,” etc. Appellants’ arguments also refer to these item numbers and we will also in this decision.

simply reiterated the features recited in claims 18-20 and drawn a conclusion, without more, that the features in Forecast Pro identified by the Examiner do not correspond to such claimed features. Such arguments do not, in our view, satisfy Appellants' burden of providing evidence and/or arguments which show how the Examiner has erred in presenting a prima facie case of anticipation.

For example, Appellants contend that, in contrast to Forecast Pro's "expert system" and "forecasting technique," the language of claim 18 requires the selection, by an arbiter, of a personalization engine by analyzing at least one profile element. In support of this contention, Appellants argue (Br. 7) that the expert system in Forecast Pro, which the Examiner asserts corresponds to the claimed arbiter, merely "analyzes data and 'selects the appropriate forecasting technique.'" It is our opinion, however, that, although Forecast Pro uses different nomenclature from that claimed, the disclosed operation of the expert system in Forecast Pro, which Appellants correctly summarize, corresponds precisely to that which is claimed.

In other words, we find no error in the Examiner's finding that the user's historical data analyzed by the expert system in Forecast Pro corresponds to the claimed "profile element," especially in view of Appellants' description of a "profile element" in the Specification (5:5-11). Similarly, we agree with the Examiner's finding (Answer 14) that Forecast Pro's forecasting model technique corresponds to the claimed personalization engine. As explained by the Examiner, Forecast Pro describes the use of various forecasting models to analyze a user's historical data to develop forecast reports, which description corresponds, in our view, to Appellants' description (Specification 6-7) of a personalization engine as

one which analyzes user data to generate new content and predict future behavior.

Further, we agree with the Examiner's characterization of the disclosed expert system of Forecast Pro as one which analyzes user historical data and selects the appropriate forecasting technique for a user's needs. In other words, with reference to the language of claim 18, we find that the expert system of Forecast Pro is an "arbiter" which analyzes "profile elements" in the form of user historical data to select a "personalization engine," i.e., forecasting model techniques, to develop a forecast tailored to a user's individual requirements.

With respect to dependent claims 19 and 20, Appellants' arguments (Br. 8-9) to the contrary notwithstanding, we find that the Examiner (Answer 3-4, 15) has explained exactly how the disclosure of Forecast Pro satisfies the claimed requirements. We find no persuasive arguments from Appellants that convince us of any error in the Examiner's position that the designated items 4 and 5 on pages 3 and 4 of Forecast Pro describe the claimed features of personalized content object sending (claim 19) and profile database access (claim 20).

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Forecast Pro, the Examiner's 35 U.S.C. § 102(a) rejection of claims 18-20 is sustained.

35 U.S.C. § 103(a) REJECTIONS

Appellants' arguments (Br. 10-17; Reply Br. 3-5) in response to the Examiner's obviousness rejection of independent claims 1 and 8 based on the combination of Kadowaki and Forecast Pro assert a failure by the

Examiner to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied Kadowaki and Forecast Pro references. With respect to the Kadowaki reference, our review of Appellants' arguments reveals that they follow a similar format to those made with regard to the anticipation rejection of claims 18-20 based on Forecast Pro.

In other words, Appellants have merely repeated the recited features of claims 1 and 8, repeated the passages cited by the Examiner from Kadowaki, and have drawn the conclusion, without more, that the cited passages do not teach or suggest the claimed features. We find no error, and there are no persuasive arguments from Appellants that show any error, in the Examiner's finding (Answer 5 and 15-17) that Kadowaki's disclosure can be reasonably interpreted as describing the arbiter, selection from plural personalization engines, and personalized content database retrieval features of appealed claims 1 and 8. Appellants' arguments with respect to dependent claims 2, 4, 6, 9, and 12-17, mentioned separately in the principal Brief, follow the same format as those made with respect to claims 1 and 8, and are equally unpersuasive.

We also agree with the Examiner that Forecast Pro discloses the claimed feature of "the arbiter refining and altering a selection based on a number and type of the profile element." Appellants' arguments have shown no error in the Examiner's finding (Answer 5) that the designated items 2 and 3 of Forecast Pro disclose the selection of the particular forecasting technique, i.e., personalization engine, based on the number and type of the profile element. In our view, the Examiner is correct in the assertion that the claimed number and type of profile element could be

reasonably interpreted as corresponding to Forecast Pro's "very short" and "low volume" data quantity characterizations and "volatile" and "sparse" profile element types associated with the Simple Methods and Low Volume Models forecasting techniques. We also find no persuasive arguments from Appellants that convince us of any error in the Examiner's establishment of proper motivation (Answer 6) for the proposed combination of Kadowaki and Forecast Pro.²

We also make the observation that, in making the obviousness rejection of claims 1 and 8, the Examiner has relied on Forecast Pro solely for a teaching of the altering and refining of a selection of a personalization engine based on profile element number and type. It is apparent to us, however, from our own independent review of Forecast Pro, as well as the Examiner's analysis of Forecast Pro in relation to the anticipation rejection of claims 18-20, that other of the features set forth in appealed claims 1 and 8 are also present in Forecast Pro.

For example, we find in Forecast Pro, as did the Examiner, a teaching which corresponds to the claimed passing of a request object with a profile element to an arbiter. The Examiner, in analyzing previously discussed claim 19, directed attention to item 1 of Forecast Pro which describes the passing of a profile element in the form of user historical data to an expert system, i.e., an arbiter. Similarly, we find in item 1 of Forecast Pro a disclosure of the analysis of the user historical data to select a particular forecasting technique, i.e., personalization engine. Accessing content from a

² Although Appellants contend (Reply Br. 6-7) that the Examiner has not responded to Appellants' arguments attacking the basis for the Examiner's proposed combination of Kadowaki and Forecast Pro, we find no such arguments in Appellants' principal Brief on appeal.

database to retrieve personalized content identified by the personalization engine, as set forth in independent claims 1 and 8, is also suggested by item 4 of Forecast Pro which describes the output of the selected forecasting technique, i.e., personalization engine, to provide database access.

In view of the above discussion and analysis of the disclosure of the Forecast Pro reference, it is our opinion that, although we found no error in the Examiner's proposed combination of Kadowaki and Forecast Pro, as discussed *supra*, the Kadowaki reference is not necessary for a proper rejection of at least independent claims 1 and 8 since all of the claimed elements are in fact present in the disclosure of Forecast Pro. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

For the above reasons, since it is our opinion that the Examiner's *prima facie* case of obviousness has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of claims 1, 2, 4, 6, 8, 9, and 12-17, is sustained.

We also sustain the Examiner's obviousness rejection of dependent claims 3, 5, 10, and 11, in which the Kurtzman, II reference is added to the combination of Kadowaki and Forecast Pro, as well as the rejection of dependent claim 7, in which the Jacobi and Tetzlaff references are added to Kadowaki and Forecast Pro. Appellants have provided no separate arguments relative to the patentability of these claims but, rather, have

Appeal 2007-0987
Application 09/810,992

chosen to let these claims stand or fall with their parent independent claims 1 and 8.

CONCLUSION

In summary, we have sustained the Examiner's rejections of all the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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